

Remarks:

Applicants respectfully request reconsideration of the Office action dated June 17, 2004. Prior to entry of the present amendment, claims 1-53 remained pending in the application.

Applicants initially note, with appreciation, that the Examiner has allowed claims 32-39, and has indicated allowability of claims 3-8, 19-21 and 29 if rewritten in independent form to include the features of the base claim, and any intervening claims.

The Examiner has, however, rejected claims 1, 2, 9-18, 22, 24-28, 30, 31 and 40-47 and 49-53 under 35 U.S.C. § 102(a), (b) and (e) as being anticipated variously by Childers (US 6,116,723), Suzuki (US 5,216,452), Fishman (US 3,940,031), Celorier, Jr. et al. (US 5,778,679), Spry et al. (US 6,260,544), Ellsworth (US 6,360,729) and Faris et al. (US 6,558,825). Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Faris et al. Claim 48 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Childers or Suzuki, each in view of Basa (US 3,782,598). The Examiner also rejected claims 50-52 were under 35 U.S.C. § 112, second paragraph, as being indefinite.

By this amendment, applicants have amended claims 3, 6, 7, 9, 13-15, 17, 19, 22, 24, 27, 29, 40, 47 and 50-52, and have cancelled claims 1, 2, 30 and 31 without prejudice.

Claims 3, 6, 7, 19 and 29 have been amended to place such claims in independent form, pursuant to the Examiner's indication that such claims would be allowable if placed in independent form. Claims 9, 13-15, 17, 22, 24, 27 and 50-52 have been amended to depend from newly independent claims, also in view of the

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Examiner's indication of allowability of such newly independent claims. Claim 47 has been amended to address a minor typographical error. Claim 40 is addressed with particularity below.

Allowance of the claims which remain pending upon entry of this amendment, claims 3-29 and 32-53, is respectfully requested in view of the foregoing amendments and following remarks.

Rejections under 35 U.S.C. § 112

As noted above, the Examiner rejects claims 50-52 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner asserts that these claims recite that the keying element is indicative of various aspects of the fuel in the fuel supply, but do not point out any particular structure. The Examiner thus concludes that the claims are indefinite. Applicants respectfully disagree.

Prior to the present amendment, each of claims 50-52 recite that the "keying element is indicative of...." Each claim thus further defines such keying element in terms of what such keying element does. This type of definition is permitted under 35 U.S.C. § 112. In fact, MPEP 2173.05(g) specifically indicates that "there is nothing inherently wrong with defining some part of an invention in functional terms (citing *In re Swinehart*, 439 F.2d 210 (CCPA 1971)). The Examiner's requirement of particular structure thus is unfounded.

Nevertheless, in the interest of furthering prosecution on the merits, applicants have amended each of claims 50-52 to more directly characterize structure of the keying element. In particular, each claim now recites the "the keying element is configured to indicate...." It is believed that this makes each of the claims more clear.

Accordingly, the Examiner's rejection of claims 50-52 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

Rejections under 35 U.S.C. § 102(a) (b) and (e)

Turning now to the merits, it is once again noted that the Examiner has rejected claims 1, 2, 9-18, 22, 24-28, 30, 31 and 40-47 and 49-53 under 35 U.S.C. § 102(a), (b) and (e) as being anticipated variously by Childers (US 6,116,723), Suzuki (US 5,216,452), Fishman (US 3,940,031), Celorier, Jr. et al. (US 5,778,679), Spry et al. (US 6,260,544), Ellsworth (US 6,360,729) and Faris et al. (US 6,558,825).

Applicants note, however, that none of Childers, Suzuki, Fishman and Celorier, Jr. et al. disclose a "fuel storage area," and that none of such references disclose a "fuel solution outlet." These features are recited in each of applicants' claims.

Furthermore, the features are structural in nature, and thus must be given patentable weight. In fact, applicants claims recite that the "fuel solution outlet [is] configured to pass a fuel solution from the fuel storage area," which further structurally distinguishes applicants' claims from the disclosures of Childers, Suzuki, Fishman or Celorier, Jr. et al. The Examiner's rejections under 35 U.S.C. § 102(b) based on Childers, Suzuki, Fishman or Celorier, Jr. et al. thus must be withdrawn.

Upon withdrawal of the Examiner's rejections under 35 U.S.C. § 102(b) based on Childers, Suzuki, Fishman or Celorier, Jr. et al., rejections of claims 1, 2, 9-18, 22, 30 and 31 under 35 U.S.C. § 102(a) and (e) based variously on Spry et al. (US 6,260,544), Ellsworth (US 6,360,729) and Faris et al. (US 6,558,825) would remain. However, pursuant to the present amendment, applicants have cancelled claims 1, 2, 30 and 31 without prejudice, and has amended claims 9, 13-15 and 17 and 22 to depend from newly-independent claims which the Examiner has indicated would be allowable if placed in independent form (claims 10-12, 16 and 18 depend from claims 9, 15 and 17). The rejections under 35 U.S.C. § 102(a) and (e) based on Spry et al. (US 6,260,544), Ellsworth (US 6,360,729) and Faris et al. (US 6,558,825) are fully overcome, and claims 9-18 and 22 are understood to be in allowable form.

Claims 24, 27 and 50-52 also have been amended to depend from newly-independent claims (based on the Examiner's indication of allowability of such newly-independent claim), and thus also are understood to be in allowable form. Claims 25, 26 and 28 depend from claims 24 and 27, and thus are understood to be in allowable form as well.

Claim 40 now recites "a keying element configured to direct the fuel supply into a fuel supply receptacle in an electronic device in a correct orientation, the keying element having a configuration indicative of at least one of a type of fuel stored in the fuel supply, a grade of fuel stored in the fuel supply and a safety aspect of the fuel stored in the fuel supply." Applicants note, however, that neither Childers nor Suzuki disclose "a keying element having a configuration indicative of at

least one of a type of fuel stored in the fuel supply, a grade of fuel stored in the fuel supply and a safety aspect of the fuel stored in the fuel supply," as recited in claim 40. The rejections of claim 40 under 35 U.S.C. § 102(b) based on Childers and Suzuki thus must be withdrawn for at least this reason.

Claims 41-47, 49 and 53 depend from claim 40, and thus are allowable for at least the same reason as claim 40. The rejections of claims 41-47, 49 and 53 under 35 U.S.C. § 102(b) based on Childers and Suzuki thus must be withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claim 23 stands rejected under 35 U.S.C. § 103(a) based on Faris et al. Claim 48 stands rejected under 35 U.S.C. § 103(a) based on Childers or Suzuki, each in view of Basa. Claim 23 depends from claim 22 (which now depends from claim 7), and thus is understood to be allowable for at least the same reasons as claim 22. Claim 48 depends from claim 47 (which depends from claim 40), and is understood to be allowable for at least the same reasons as claim 47. Furthermore, with respect to claim 48, it is noted that Childers and Suzuki both concern ink containers, and that Basa concerns a gun-like applicator. The references are not suitable for combination, and are in no way analogous to a fuel supply for a fuel cell, and thus are not properly cited herein. The rejection of claim 48 thus must be withdrawn for this reason as well.

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

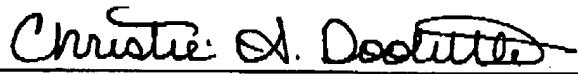
Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner S. Kalafut, Group Art Unit 1745, Assistant Commissioner for Patents, at facsimile number (703) 872-9306 on October 18, 2004.



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